

Applicant: Granger
Serial No.: 09/966,028

Attorney Ref.: 1759.053

Remarks

By the above Amendments, the Patent Owner has replaced pending claims 1 through 15 with new claims 16 through 33. Claims 16 through 33 are now pending in this application. Entry of these Amendments, reconsideration of the positions presented in this Office Action, and allowance of the claims now pending are respectfully requested. Pursuant to 37 CFR 1.530(j), the scope of the claims in the subject patent was not enlarged and no new matter was introduced.

Claim 16 through 33 reflect the proposed claims faxed to Examiner Dexter on April 8, 2003. These claims were also discussed in a phone conversation on April 11, 2003. The Applicant recognizes with appreciation Examiner Dexter's assistance in discussing these claims and advancing the application to Allowance.

The Patent Owner in no way acquiesces in any rejection previously made by the Patent Office. Rather, the amendments made herein alleviate the need of further argument relating to any rejection

Response to Comments in Office Action

In paragraphs 3, 4, and 5 on pages 2 and 3 of the Action, the Patent Office objected to certain wording in the Abstract and Specification. The Applicant believes that the above Amendment overcomes these rejections. Again, the Applicant recognizes with appreciation Examiner Dexter's assistance in overcoming these objections.

In paragraphs 6 and 7 on pages 4 and 5 of the Action, the Patent Office rejected claims 1 through 15 pursuant to the first and second paragraphs of 35 USC §112. The

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Applicant believes that the claims introduced in the above Amendment overcome these rejections.

Response to Anticipation Rejection based upon Fleischauer

In paragraphs 8 and 9 on page 5 of the Action, the Patent Office rejected claims 1-3, and 7-11 under 35 USC §102(b) as anticipated by US patent 3,961,700 of Fleischauer [herein "Fleischauer"]. However, the Applicant again submits that this rejection is inappropriate in view of the newly introduced claims 16 through 33.

MPEP § 2131 defines the conditions under which an anticipation rejection is appropriate:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim...

The Applicant submits that Fleischauer does not disclose "the identical invention" containing "each and every element" as recited in new claims 16 through 33. Fleischauer is simply not analogous art. For example, the machine disclosed by Fleischauer is clearly not a "paper strip dispensing and cutting apparatus" as recited in claim 16 and disclosed in the present specification. As described in the Abstract of Fleischauer, the invention disclosed by Fleischauer is "a conveyor construction". The Applicant respectfully submits that Fleischauer's "conveyor construction" in no way

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could be used to dispense paper strips, for example, paper towels, toilet paper, and the like. Clearly, this rejection is inappropriate and the Applicant respectfully requests that this rejection be reconsidered.

In addition, not only is Fleischauer clearly not a "paper strip dispensing and cutting apparatus", even if Fleischauer were, for the sake of argument, such a device, Fleischauer does not disclose (1) "a drum...having at least one groove" or (2) "a shaft...having an outer diameter and a central section having a diameter less than the outer diameter, and the central section having a width greater than the width of the at least one groove of the drum". The Office Action identifies Figure 3A of Fleischauer for support of its position, implying that roller 28a of Fleischauer is somehow a "drum". This is clearly not the case. Examination of Fleischauer reveals that the disclosed conveyor conveys articles 40 by means of rollers 28, 28a; rollers 28, 28a are not drums, as claimed and clearly disclosed in the subject application.

In addition, the Office Action identifies shaft 48a of Figure 3A as the claimed "shaft". However, though shaft 48a may have a groove, this groove does not have "a width greater than the width of the at least one groove of the drum". Assuming, for the sake of argument, that shaft 28a is a drum (which it is not) having a groove 58, as shown in Figure 2 of Fleischauer, groove 58 has a substantial width compared to the grooves of shaft 48a. In contrast to the present invention, the groove in shaft 48a does not have "a width greater than the width of the at least one groove on the drum".

Again, even if Fleischauer is analogous art, Fleischauer fails to anticipate the invention of claim 16 and its dependents.

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Response to Anticipation Rejection based upon Granger '035

In paragraph 10 on page 6 of the Action, the Patent Office rejected claims 1, 2, 4, 5, and 7-15 under 35 USC §102(b) as anticipated by US patent 4,846,035 of Granger [herein "Granger '035"]. However, the Applicant again submits that this rejection is inappropriate in view of the newly introduced claims 16 through 33.

First, Granger is the Applicant's very own patent, with which the Applicant is intimately familiar. Granger comprises the very art over which the present invention is an improvement.

Second, Granger, like Fleischauer, does not disclose "the identical invention" containing "each and every element" as recited in new claims 16 through 33. For instance, Ganger does not disclose "a central section having a diameter less than the outer diameter, and the central section having a width greater than the width of the at least one groove of the drum" as recited in claim 16. The roll 11 of Granger includes a groove (not identified) that engages belt 12, but the groove of Granger does not have a width greater than the width of the groove in drum 7 of Granger. By this distinction alone, the Applicant submits that claim 16 and its dependents are not anticipated by Granger.

Furthermore, since Granger discloses a "cutting device", as recited in its title and its abstract, Granger discloses essentially nothing about the groove in roll 16 or whether it is desirable to in anyway to vary the size of the groove. Granger clearly does not teach or even suggest that the width of its groove in roll 11 can be widened to allow "the at least one belt to deflect laterally over an amplitude "α" when a paper strip is pulled laterally", as recited in claim 16.

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Response to Obviousness Rejection based upon Fleischauer and Granger '837

In paragraph 13 on page 7 of the Action, the Patent Office rejected claims 1-15 under 35 USC §103(a) as obvious in view of US patent 4,653,837 of Granger [herein "Granger '837"] and Fleischauer. However, the Applicant again submits that this rejection is inappropriate, especially, in view of the newly introduced claims 16 through 33.

First, Granger '837 corresponds to European Patent 145,622. Both documents claim priority from the same French application. EP 145,622 is discussed in the present specification. The disadvantages of the invention disclosed in Granger '837 (see page 2, line 22 to page 3, line 24) are also discussed by the Applicant. These disadvantages will not be repeated here, the Patent Office is referred to the speciation.

Second, the Patent Office admits that Granger '837 lacks the claimed "shaft". The Applicant agrees; Grange '837 does not disclose the claimed "shaft...having an outer diameter and a central section having a diameter less than the outer diameter, and the central section having a width greater than the width of the at least one groove of the drum". Grange '837 discloses a shaft 38 having a groove 38a, but groove 38a does not have "a width greater than the width of the at least one groove of the drum". As shown in Figure 2, Granger '837 discloses a drum 3 having a groove 3c, but groove 38a is not wider than groove 3c. Specifically, groove 38a is not wider than groove 3c whereby "the width of [groove 38a] of the shaft allows the at least one belt to deflect laterally over an amplitude "a" ". Furthermore, there are no teachings or suggestions in Granger '837 that the width of groove 38a can or should be any wider than the width shown in Figure 2 of Granger '837.

The deficiencies of Granger '837 are not remedied by Fleischauer. As discussed

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above, Fleischauer is not analogous art, and, even if it were analogous art, Fleischauer does not teach or suggest the present invention.

The Applicant submits that, since the inventions of claims 16 and its dependents are not disclosed or suggested by Granger '837 and Fleischauer, these inventions are non-obvious in view of these references.

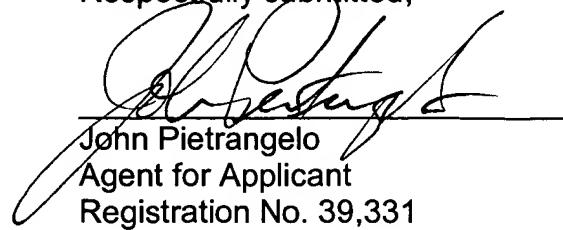
The Applicant believes that new claims 16-33 are presented in allowable form. The Applicant respectfully requests that these claims be allowed and advanced to issue.

Request for Interview

If the Patent Office is still of the opinion that the subject matter of the pending claims does not constitute patentable subject matter, the Applicant requests an interview with the Examiner pursuant to section 706.07(b) of the MPEP.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicant's undersigned agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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